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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,249	03/14/2001	Joseph P. Steiner	06843.0036-00000	1312

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EXAMINER	
KIM, VICKIE Y	16

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,249	STEINER ET AL.	
	Examiner	Art Unit	
	Vickie Kim	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-48 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to a method of treating a neurological disorder in an animal comprising administering to said animal an effective amount of a compound having of formula II.

II. Claims 1, 2, 11, 17-24, drawn to a method for preventing neurodegeneration in an animal comprising administering to said animal an effective amount of a compound having of formula II.

III. Claims 1, 2, 11, 25-32, drawn to a method for promoting neuronal regeneration and/or growth in an animal comprising administering to said damaged peripheral nerve an effective amount of a compound having of formula II.

IV. Claims 1, 2, 11, 33-40, drawn to a method for stimulating the growth of damaged peripheral nerve comprising administering to said nerve cell an effective amount of a compound having of formula II.

V. Claims 1, 2, 11, 41-48, drawn to a method for stimulating neurite outgrowth by a nerve cell in an animal comprising administering to said nerve cell an effective amount of a compound having of formula II.

2. Inventions I and II(or III or IV or V) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04,

MPEP § 808.01). In the instant case the different inventions, they requires different modes of operations(e.g. routes of administration such as animal, damaged peripheral nerve or nerve cells) or they have different effects, for example, preventing neurological degeneration is different from stimulating neurological regeneration. Each distinctive invention can be achieved by materially different product as well.

Because these inventions are distinct for the reasons given above and the search required for each group is not same, wherein a reference which anticipates the invention of Group I would not render the invention of Group II or III or IV or V obvious, absent ancillary art, restriction for examination purposes as indicated is proper.

3. Upon the election of the group, further restriction to one of the following inventions is required:

I(a) Claims 1-4, 5-7, 11-15, drawn to a method for treating a neurological disorder using a compound having of formula II having 5 membered heterocyclic ring , classified in class 514, subclass 359, 428.

I(b) Claims 1-4, 8-10, 11-14 and 16, drawn to a method for treating a neurological disorder using a compound having of formula II having 6 membered heterocyclic ring, classified in class 514, subclass 315.

II(a) Claims 1, 2, 11, 17-20, 24, drawn to a method for preventing neurodegeneration using a compound having of formula II having 5 membered heterocyclic ring , classified in class 514, subclass 359, 428.

II(b) Claims 1, 2, 11, 17-24, drawn to a method for preventing

Neurodegeneration a compound having of formula II having 6 membered heterocyclic ring, classified in class 514, subclass 315.

III(a) Claims 1, 2, 11, 25-26, 27-29, drawn to a method for promoting neuronal regeneration and/or growth using a compound having of formula II having 5 membered heterocyclic ring , classified in class 514, subclass 359, 428.

III(b) Claims 1, 2, 11, 25-26, 30-32, drawn to a method for promoting neuronal regeneration and/or growth using a compound having of formula II having 6 membered heterocyclic ring, classified in class 514, subclass 315.

IV(a). Claims 1, 2, 11, 33-34, 35-37, drawn to a method for stimulating the growth of damaged peripheral nerve using a compound having of formula II having 5 membered heterocyclic ring , classified in class 514, subclass 359, 428.

IV(b) Claims 1, 2, 11, 33-34, 38-40, drawn to a method for stimulating the growth of damaged peripheral nerve using a compound having of formula II having 6 membered heterocyclic ring, classified in class 514, subclass 315.

V(a). Claims 1, 2, 11, 41-12, 43-45, drawn to a method for stimulating neurite outgrowth by a nerve cell using a compound having of formula II having 5 membered heterocyclic ring, classified in class 514, subclass 359, 428.

V(b) Claims 1, 2, 11, 41-12, 46-48, drawn to a method for stimulating neurite outgrowth by a nerve cell using a compound having of formula II having 6 membered heterocyclic ring, classified in class 514, subclass 315.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for each group is not same, wherein a reference which anticipates the invention of Group I would not render the invention of Group II or III or IV or V obvious, absent ancillary art, restriction for examination purposes as indicated is proper. Even if there were unity of classification, the search of entire groups and/or genus in the non-patent literature(especially, non-patent literature) and database search (a significant part of a thorough examination) would be burdensome, it is undue burden for examiner for the accurate and proper examination, restriction for examination purposes as indicated is proper.

Election of species

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species(e.g. specific examples in the specification), from under the instant claims of the elected group. If group I is elected, applicant is further required to elect patentably distinct species of neurological disorder recited in claims 3-4 and 13-14. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon. With the election of a specific exemplified compound, a generic concept will be identified by the examiner as the inventive group for examination.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed(37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 703-305-1675. The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3165 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Vickie Kim,
Patent examiner
March 19, 2003
Art unit 1614